

IN THE UNITED STATES AND TRADEMARK OFFICE

RE: Patent Application for : Date: March 14, 2000
R. A. Heiberger : Group: 3727
Serial No.: 09/237,687 : Examiner:
Filed: January 26, 1999 : Action: **RESPONSE TO**
For: **A FLUID CONTAINER** : **RESTRICTION**
CLOSURE MECHANISM : **REQUIREMENT AND**
WITH DETACHABLE : **PRELIMINARY**
VALVE ASSEMBLY : **AMENDMENT**



To: The Commissioner of Patents and Trademarks
Washington, DC 20231

Sir:

In response to the Office Action dated February 15, 2000, please amend the above identified patent application as follows:

In the Claims:

Kindly add the following claim:

33. The fluid container of claim 1, wherein said valve body is constructed from elastic material to permit selective deformation and removal thereof from said outlet passageway.

Response to Restriction with Traverse

This Response is to the Official Communication dated February 15, 2000. Claims 1-32 were pending and were made subject of a restriction requirement. Specifically, the Examiner restricted the claims into three groups alleging that each group was distinct as being drawn to a combination and sub-combination. The claims were grouped as follows:

Group I: Claims 1-9

Group II: Claims 10-28

Group III: Claims 29-32

The Examiner first describes claims 29-32 as a combination with claims 1-9 being a sub-combination. Second, the Examiner describes claims 29-32 as a combination with claims 10-28 being a sub-combination. Finally, the Examiner has described claims 1-9 as a combination with claims 10-28 being a sub-combination. Applicant respectfully traverses the first restriction relating to claims 29-32 and 1-9, only.

In order to determine whether a restriction is proper, it is necessary to compare the claimed subject matter to determine the distinctiveness or independence. MPEP §806.01. The criteria of distinctiveness is set forth in MPEP §806.05(c). The essential test is whether the combination, as claimed, requires the particulars of the sub-combination for patentability. If not then the next step is to determine whether the sub-combination has its own utility alone or in different relations.

Turning to the present invention, Combination Claim 29 recites:

29. A fluid container comprising an enclosure for containing liquid and a first closure member in the form of a fluid discharge assembly including a selectively removable valve body mounted for movement between an open position to permit flow of liquid from said enclosure and a closed position to prevent flow of liquid through said fluid discharge assembly.

Sub-Combination Claim 1 recites:

1. A closure for a container that is adapted to hold a product for dispensing, comprising:
 - (a) a cap member mountable to a container, said cap member having a product outlet passage; and
 - (b) a valve body disposed for longitudinal movement within said outlet passage between an open position to permit flow of product through said passage from said container and a closed position to prevent flow of product through said passage, said valve body being selectively removable from said outlet passage.

The combination claim thus recites an enclosure for holding liquid and a closure member for the enclosure. The closure has a discharge assembly with a selectably removable valve that moves between an open and closed position. The subcombination claim 1 recites the closure for the container that has a removable valve body that moves between an open and closed position. The difference in the recitations is that the sub-combination refers to the removable valve as being in a cap that mounts to the container. On the other hand, claim 29 recites "a first closure member" for the enclosure. Applicant suggests that such recitation encompasses the "cap" of claim 1.

"Where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should never be required. MPEP §806.03. "This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition." *Id.* This is precisely the situation faced with respect to Claims 29--32 and Claims 1-9. While "first closure member" may have greater scope of definition than "cap", they nonetheless relate to the same disclosed subject matter, for any "closure" for a container could be viewed as a "cap".

Thus, restriction between claims 1-9 and 29-32 is improper. The Examiner is requested to reconsider this restriction and remove the same. The situation is different with respect to claims 10-28. Here, the claims recite the sub-combination to be a valve member having a body constructed of an elastic material. Since this feature is not recited in the other claims, it may be subject to restriction. However, the restriction requirement perhaps should

have been between genus and species rather than combination and sub-combination. In such case, claims 1 and 29 would be generic. In such event, the allowance of a generic claim would allow the species to be included without necessitating a divisional application.

In any event, Applicant hereby withdraws claims 10-28 from examination, subject to either the Examiner determining them to be a restricted species that may be allowed with the allowance of a generic or the filing of a divisional application. In addition, it is noted that the present response adds a new claim 33 that is dependent on claim 1; this claim recites that the valve body of claim 1 is constructed of flexible material.

In the event that the Examiner maintains his position with respect to restriction between claims 1-9 and 29-32, then Applicant elects to pursue claims 1-9 and newly added claim 33 that depends on claim 1. In such case, Applicant withdraws claims 29-32 from examination, subject to the filing of a divisional application. However, Applicant strongly urges the Examiner to consider these claims in one application since they are subject of a single combination of a container and a closure for that container.

Due to this Amendment, a new filing fee calculation is provided, as follows:

Maximum Total Claims This Amendment	Total Claims Previously Paid For	
33	32	= 1 x \$ 9.00 = \$9.00
Total Independent Claims Per This Amendment	Maximum Independent Claims Previously Paid For	

3 - 3 = 0x \$39.00 = \$0.00

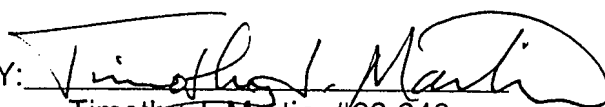
Additional Filing Fee Due \$9.00

Accordingly, our check no. 14763 in the amount of \$9.00 is enclosed. The Commissioner is hereby authorized to charge any deficiency in the payment of the required fee(s) or credit any overpayment to Deposit Account No. 13-1940.

Respectfully submitted,

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CERTIFICATE OF MAILING UNDER 37 C.F.R. 1.8

I hereby certify that the attached **RESPONSE TO RESTRICTION REQUIREMENT AND PRELIMINARY AMENDMENT INCLUDING CHECK NO. 14763 IN THE AMOUNT OF \$9.00 FOR THE EXTRA CLAIM FEE** is being deposited with the United States Postal Service as first-class mail in an envelope addressed to Application Processing Division, The Commissioner of Patents and Trademarks, Washington, DC 20231, on this 15th day of March, 2000.

